

Attorney Docket # 4925-137PUS

Serial No. 09/914,307
Amtd. dated April 15, 2004
Reply to Office Action dated January 15, 2004

REMARKS/ARGUMENTS

In the present amendment, all of the pending claims (Claims 1-5) have been amended in order to conform with U.S. patent practice, including, for example, (a) replacing "characterised in that" with "wherein"; (b) deleting reference numerals (to thereby emphasize that the claims are in no way limited to the embodiments shown in the drawings); and (c) moving phrases to more appropriate positions within the claims. None of the claim amendments were made for reasons of patentability, as is evident by their nature, and none of the claim amendments were made in response to the rejections in the January 15, 2004 Office Action. The specification has been amended to conform with U.S. patent practice and to fix some minor errors. In addition, the specification now recites the priority claim which has already been submitted to, and acknowledged by, the U.S. Patent and Trademark Office (see Notification of Missing Requirements under 35 U.S.C. 371 dated October 25, 2001, the Filing Receipt dated December 7, 2001, or the Summary Sheet of the present Office Action).

In the present amendment, fourteen claims have been added: independent Claims 6 and 20, as well as Claims 7-19 depending from Claim 6. None of these newly-added claims contain new matter.

Newly-added Claim 6 is supported at least by originally-filed Claim 1, the text at lines 6-15 on page 6 of the originally-filed specification, and FIG. 4.

Newly-added Claims 7-9 and 11 are supported at least by the text at lines 7-20 on page 5 and line 28 of page 5 to line 5 of page 6 in the originally-filed specification and FIGS. 3 and 4.

Newly-added Claims 10 and 13-15 are supported at least by the text at lines 21-31 on page 6 of the originally-filed specification and FIGS. 3 and 4.

Newly-added Claim 12 is supported at least by the text at lines 12-13 and 30-31 on page 5 and lines 8-9 on page 6 of the originally-filed specification and FIGS. 2, 3, and 4.

Newly-added Claim 16 is supported at least by the text at lines 29-31 on page 6 of the originally-filed specification and FIG. 4.

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Newly-added Claim 17 is supported at least by the text at lines 14-18 on page 5 and lines 3-5 on page 6 of the originally-filed specification and FIGS. 2 and 3.

Newly-added Claim 18 is supported at least by the text at lines 30-31 on page 5 and lines 8-9 on page 6 of the originally-filed specification and FIGS. 3 and 4.

Newly-added Claim 19 is supported at least by the text at line 31 on page 5 and line 9 on page 6 of the originally-filed specification.

Newly-added Claim 20 is supported at least by the text at line 28 on page 5 to line 5 on page 6 of the originally-filed specification and FIG. 3.

Newly-added independent Claim 6 is in condition for allowance at least because the prior art neither teaches nor suggests the step of "suggesting, by the radio access network, a cell to be used by the mobile station in the common channel state", which is recited in Claim 6.

Newly-added dependent Claims 7-19 are in condition for allowance at least through their dependence on Claim 6, which is in condition for allowance.

Newly-added independent Claim 20 is in condition for allowance at least because the prior art neither teaches nor suggests "selecting, by the radio access network, a cell to be used by the mobile station in the common channel state" "if the radio access network determines that there will be only common channel connections left between the mobile station and the radio access network after [a] procedure commanded by [a] control message [which is to be sent by the radio access network] has been completed", which is recited in Claim 20.

The Office Action mailed January 15, 2004 has been reviewed and carefully considered. In the Office Action, the Examiner rejected Claims 1-5 under 35 USC §103(a) as unpatentable over *Lupien et al.* (US 5,797,096) in view of *Tiedemann Jr. et al.* (US 6,216,004). Unfortunately, the Examiner has not provided sufficient support for his rejection; thus, applicants can only ask that the Examiner either provide support for the rejection or withdraw the rejection.

Independent Claim 1 of the present application recites the steps of: "selecting, by the network, a cell to be suggested as the cell for use by the mobile station in the cell-connected state"

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and "indicating, by the network, said selected cell to be suggested by attaching cell identification information as a parameter to a message initiating a change of the mobile station to the cell-connected state". These steps are neither taught nor suggested by any of *Lupien*, *Tiedemann*, or their combination. The Examiner, as far as can be understood, appears to suggest that *Tiedemann* teaches or suggests these steps, and that *Lupien* teaches or suggests the other limitations recited in Claim 1 (see the paragraph starting on line 11 of page 2 in the Office Action). The Examiner cites four passages in *Tiedemann* in support of his rejection of the two steps in Claim 1: Lines 35-46 of Col. 1; Lines 13-59 of Col. 3; Lines 54-67 of Col. 8; and Lines 1-11 of Col. 9 (lines 8-9, page 3, Office Action).

Lines 35-46 of Col. 1 of *Tiedemann* provides a general description of how cellular system works, i.e., radiofrequency (RF) signals are exchanged between mobile stations and base stations, which are connected to a base station controller (BSC), which, in turn can route calls to the Internet or a public switching telephone network (PSTN). There is nothing in this passage that teaches or suggests the two steps of Claim 1.

Lines 13-59 of Col. 3 of *Tiedemann* describes how "soft handoff", which is when a mobile station is handed off from one base station to another, but simultaneously exchanges identical communications traffic on a CDMA traffic channel with both (or more) base stations. The passage describes how the cellular system determines whether to perform a soft handoff, and provides details concerning the "Active Set", the "Candidate Set", and the "Neighbor Set" of base stations. There is nothing in this passage that teaches or suggests the two steps of Claim 1.

The passage consisting of lines 54-67 of Col. 8 and lines 1-11 of Col. 9 of *Tiedemann* describes (1) how a mobile station detects and measures pilot signals, and then transmits that information to the BSC, which determines whether to perform soft handoffs or not; and (2) how pilot offsets are used to identify the various sets of base stations. Yet again, there is nothing in this passage that teaches or suggests the two steps of Claim 1.

Applicants' attorney has no idea how or why the Examiner believes those passages from *Tiedemann* teach or suggest the steps of "selecting, by the network, a cell to be suggested as the

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cell for use by the mobile station in the cell-connected state" and "indicating, by the network, said selected cell to be suggested by attaching cell identification information as a parameter to a message initiating a change of the mobile station to the cell-connected state" as recited in Claim 1 of the present application.

If one attempts to combine those passages of *Tiedemann* with the passages the Examiner cited in *Lupien*, the reasoning for the rejection become even more mysterious. *Lupien* is directed to the procedures for registering a mobile station with a wireless network, and the exchange of mobile station-related parameters to the wireless network. The parameter on which *Lupien* focuses, the control channel mode (CCM), concerns whether the mobile station is in digital or analog mode (col. 1, lines 36-37, of *Lupien*). It is a mystery how the combination of *Lupien* and *Tiedemann* is supposed to teach or suggest the steps of Claim 1 in the present application.

It is not the applicants' responsibility to guess how or why the Examiner believes the combination of *Tiedemann* and *Lupien* teaches the two steps of Claim 1. Moreover, it is not the applicants' responsibility to generate a cogent rejection based on the combination of *Tiedemann* and *Lupien* (in order that this response actually respond to a substantive argument) when the Examiner has failed to do so. It is sufficient to merely point out that the Examiner has failed to meet the burden of making a *prima facie* case for obviousness under §103 because the Examiner has not shown how the combination of *Tiedemann* and *Lupien* teaches or suggests any single one of the limitations recited in Claim 1 of the present application.

At least because the combination of *Tiedemann* and *Lupien* neither teaches nor suggests the steps of "selecting, by the network, a cell to be suggested as the cell for use by the mobile station in the cell-connected state" and "indicating, by the network, said selected cell to be suggested by attaching cell identification information as a parameter to a message initiating a change of the mobile station to the cell-connected state", as recited in Claim 1 of the present application, Claim 1 is patentable over the combination of *Tiedemann* and *Lupien*. Withdrawal of the rejection is respectfully requested.

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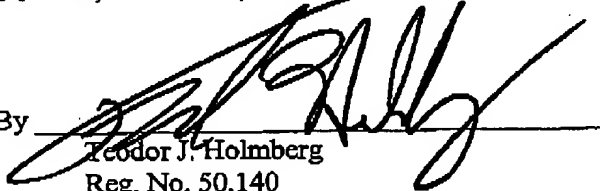
At least through their dependence on Claim 1, which is believed to be patentable over the combination of *Tiedemann* and *Lupien*, dependent Claims 2-5 are also believed to be patentable over the combination of *Tiedemann* and *Lupien*. Withdrawal of their rejection is also respectfully requested.

At least for the foregoing reasons, it is believed that all of the pending claims are in condition for allowance, which is respectfully requested.

Respectfully submitted,

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Dated: April 15, 2004